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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

RIES, LAURIE ANNE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2176

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,123

Applicant(s)

SILVERBROOK ET AL.

Examiner

Laurie Ries

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: request for continued examination, filed 11 July 2005, to the original application, filed 23 May 2000.
2. Claims 9-10 and 26 have been cancelled. Claims 1-8, 11-25, and 27-29 are pending. Claims 1 and 15 are independent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1, 11, 15, and 24-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Dymetman ("Intelligent Paper", Xerox Research Centre Europe).

As per claims 1 and 15, Dymetman discloses a system and method of delivering an interactive printed periodical to a user on demand including a computer system that is used to produce and update intelligent paper documents (See Dymetman, Page 393, Figure 1). Dymetman also discloses allocating and recording a unique document identifier, called a doc-id (See Dymetman, Page 403, first full paragraph, lines 3-5). Dymetman also discloses associating this doc-id with a document, such as a periodical, in the system (See Dymetman, Page 403, third full

paragraph, lines 1-3). Dymetman also discloses printing the document onto a substrate, such as intelligent paper sheets, using a printer networked with the computer system so as to produce printed materials, such as daily papers, meeting agendas, or hotel reservations (See Dymetman, Page 400, "Daily Papers", "Meeting agenda", and "Hotel reservations"). Dymetman also discloses that the periodical includes a number of location-indicating tags that function in cooperation with user interactive elements of the periodical, enabling a user to indicated a request for further information relating to contents of the periodical by interacting with the elements using a sensing device which is adapted to transmit data indicating the request to the computer system (See Dymetman, Pages 396-397, Section 3 – Technology).

As per claim 25, Dymetman discloses the limitations of claim 15 as described above. Dymetman also discloses printing the newspaper or magazine demand (See Dymetman, Page 400, paragraph 4 – "Daily Papers"). Dymetman also discloses printing the formatted information on paper and also printing the coded data (See Dymetman, Page 399, paragraphs 2-4 – "Visible and Invisible Inks").

As per claim 11, Dymetman discloses the limitations of claim 1 as described above. Dymetman also discloses printing the coded data to be substantially invisible in the visible spectrum (See Dymetman, Page 399, paragraphs 2-4 – "Visible and Invisible Inks").

As per claim 24, Dymetman discloses the limitations of claim 15 as described above. Dymetman also discloses that the sensing device includes a marking nib (See Dymetman, Page 401, Section 5, paragraph 2 – "Writer-Pointer").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Walker (U.S. Patent 5,995,976).

As per claim 2, Dymetman discloses the limitations of claim 1 as described above. Dymetman does not disclose expressly that the further information includes editorial content. Walker discloses including editorial information in relation to publishing newspapers or magazines electronically (See Walker, Column 1, lines 14-18, and Column 2, lines 12-15). Dymetman and Walker are analogous art because they are from the same field of endeavor of distributing data electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the editorial content of Walker with the newspaper or magazine delivery method of Dymetman. The motivation for doing so would have been to allow "surplus" information to be distributed to users thereby increasing profitability for the publisher (See Walker, Column 2, lines 24-39). Therefore, it would have been obvious to combine Walker with Dymetman for the benefit of allowing surplus information to be distributed to users

thereby increasing profitability for the publisher to obtain the invention as specified in claim 2.

5. Claims 3-4, 16-19, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Greening (U.S. Publication 2001/0013009 A1).

As per claims 3-4, 16, 18, and 19, Dymetman discloses the limitations of claims 1 and 15 as described above. Dymetman does not disclose expressly that the further information relates to advertising material, which is included in the formatted information on the basis of demographics of the user. Greening discloses the inclusion of advertising materials based on a demographic profile of a user. (See Greening, Page 1, paragraph 0015). Dymetman and Greening are analogous art because they are from the same field of endeavor of presenting information to users over a computer network. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the advertising information based on user demographics of Greening with the further information of Dymetman. The motivation for doing so would have been to create a personalized experience for the user. (See Greening, Page 1, paragraph 0014). Therefore, it would have been obvious to combine Greening with Dymetman for the benefit of providing a personalized experience for the user to obtain the invention as specified in claims 3-4, 16, 18, and 19.

As per claim 17, Dymetman discloses the limitations of claim 15 as described above. Dymetman does not disclose expressly that the further information relates to

advertising material, which is included with reference to user preferences. Greening discloses the inclusion of advertising materials based on user preferences. (See Greening, Page 1, paragraph 0015). Dymetman and Greening are analogous art because they are from the same field of endeavor of presenting information to users over a computer network. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the advertising information based on user preferences of Greening with the further information of Dymetman. The motivation for doing so would have been to create a personalized experience for the user. (See Greening, Page 1, paragraph 0014). Therefore, it would have been obvious to combine Greening with Dymetman for the benefit of providing a personalized experience for the user to obtain the invention as specified in claim 17.

As per claim 21, Dymetman and Greening disclose the limitations of claim 19 as described above. Dymetman also discloses receiving movement data as to the position of the mouse or sensing device relative to the newspaper or magazine (See Dymetman, Page 397, paragraphs 2-3).

As per claim 22, Dymetman and Greening disclose the limitations of claim 21 as described above. Dymetman also discloses sensing the movement of the mouse or sensing device using code (See Dymetman, Page 398, paragraphs 3-4).

6. Claims 5-7, 12, 20, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Nozue (U.S. Patent 5,845,262).

As per claims 5 and 20, Dymetman discloses the limitations of claims 1 and 15 as described above. Dymetman also discloses including coded data with interactive elements (See Dymetman, Page 397, paragraph 1), where the data includes receiving, in the computer system, indicating data from the sensing device and of a position of the sensing device relative to the newspaper or magazine in order determine when the sensing device is used to interact with the element (See Dymetman, Page 398, paragraph 5). Dymetman does not disclose expressly including the identity of the newspaper or magazine. Nozue discloses the inclusion of information identifying the newspaper or magazine. (See Nozue, Claim 12) Dymetman and Nozue are analogous art because they are from the same field of endeavor of providing data electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the transmittal of identity data of Nozue with the system and method of Dymetman. The motivation for doing so would have been to classify the information by location or district. (See Nozue, Column 31, lines 41-60). Therefore, it would have been obvious to combine Nozue with Dymetman for the benefit of classifying the data to obtain the invention as specified in claims 5 and 20.

As per claim 6, Dymetman and Nozue disclose the limitations of claim 5 as described above. Dymetman also discloses receiving movement data as to the position of the mouse or sensing device relative to the newspaper or magazine (See Dymetman, page 397, paragraphs 2-3).

As per claim 7, Dymetman and Nozue disclose the limitations of claim 6 as described above. Dymetman also discloses sensing the movement of the mouse or

sensing device using code (See Dymetman, Page 398, paragraphs 3-4) and identifying the response from the movement being at least partially within a certain zone associated with the interactive elements (See Dymetman, page 397, paragraphs 2-3).

As per claim 12, Dymetman and Nozue disclose the limitations of claim 6 as described above. Dymetman also discloses retaining a retrievable record of the printed newspaper or magazine, being retrievable using the identification code in the coded data (See Dymetman, Page 397, paragraph 6).

As per claim 27, Dymetman and Nozue disclose the limitations of claim 20 as described above. Dymetman also discloses printing the coded data to be substantially invisible in the visible spectrum (See Dymetman, page 399, paragraphs 2-4 – “Visible and Invisible Inks”).

As per claim 28, Dymetman and Nozue disclose the limitations of claim 20 as described above. Dymetman also discloses that the periodicals or documents are retrievable by a doc-id (See Dymetman, Page 403, first full paragraph, lines 3-5). Nozue also discloses a database for keeping a retrievable record of each periodical generated (See Nozue, Column 12, lines 13-20). Dymetman and Nozue are analogous art because they are from the same field of endeavor of providing data electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the database of Nozue with the documents of Dymetman. The motivation for doing so would have been to maintain data for later distribution (See Nozue, Column 2, lines 5-15). Therefore it would have been obvious to combine Nozue with Dymetman

for the benefit of maintaining data for later distribution to obtain the invention as specified in claim 28.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Franklin ("A Framework for Scalable Dissemination-Based Systems", ACM SIGPLAN Notices).

As per claim 13, Dymetman discloses the limitations of claim 1 as described above. Dymetman does not disclose expressly including distributing a number of newspapers or magazines using a mixture of multicast and pointcast communications protocols. Franklin discloses using a combination of delivery mechanisms, including both pointcast and multicast. (See Franklin, Page 97, column 1, paragraph 5).

Dymetman and Franklin are analogous art because they are from the same field of endeavor of delivering information electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the combination of delivery mechanisms of Franklin with the system and method of Dymetman. The motivation for doing so would have been to control the costs of initiating the transfer of data. (See Franklin, Page 5, column 2, paragraph 2) Therefore, it would have been obvious to combine Franklin with Dymetman for the benefit of controlling data transfer costs to obtain the invention as specified in claim 13.

8. Claims 14 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Wiedemer (U.S. Patent 5,860,781).

As per claims 14 and 29, Dymetman discloses the limitations of claims 1 and 15 as described above. Dymetman does not disclose expressly that the newspaper or magazine is printed on multiple pages and that the method includes binding the pages. Wiedemer discloses a binding or stitching device used to bind the pages of a document. (See Wiedemer, Column 4, lines 51-57). Dymetman and Wiedemer are analogous art because they are from the same field of endeavor of presenting information. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the binding of pages of Wiedemer with the system and method of Dymetman. The motivation for doing so would have been to produce a document simply and cost-effectively. (See Wiedemer, Column 1, lines 54-56). Therefore, it would have been obvious to combine Wiedemer with Dymetman for the benefit of producing a document simply and with reasonable cost to obtain the invention as specified in claims 14 and 29.

9. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Smith (U.S. Patent 5,181,162).

As per claims 8 and 23, Dymetman discloses the limitations of claims 1 and 15 as described above. Dymetman also discloses monitoring the sensing device (See Dymetman, page 401, Section 5, bullet item 2). Dymetman does not disclose expressly

including an identification code for a specific user. Smith discloses including an identification code for a user. (See Smith, Column 5, lines 3-7). Dymetman and Smith are analogous art because they are from the same field of endeavor of presenting information electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the user identification code of Smith with the system and method of Dymetman. The motivation for doing so would have been to restrict user access to an object. (See Smith, Column 5, lines 1-3). Therefore, it would have been obvious to combine Smith with Dymetman for the benefit of restricting user access to obtain the invention as specified in claims 8 and 23.

Response to Arguments

10. Applicant's arguments filed 11 July 2005 have been fully considered but they are not persuasive. Applicant argues on Page 7 of the Instant Amendment that Dymetman fails to disclose a computer system allocating and recording an identifier, and associating the identifier with a document in the computer system. The Office respectfully disagrees. Dymetman discloses a computer system, as shown on Page 393, Figure 1, which is used to produce and update intelligent paper documents. Dymetman also discloses, on Page 403, giving a document a unique document identifier, called a doc-id (See first full paragraph, lines 3-5). Additionally, Dymetman discloses associating this doc-id with a document, such as a periodical, in the system (See Dymetman, Page 403, third full paragraph, lines 1-3).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Reisman (U.S. Patent 6,594,692 B1) discloses methods for transacting electronic commerce.
- Meyrowitz discloses interactive editing systems.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
8/3/2005